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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/672,029  | 09/29/2000  | Jon E. Ramer         | 5371                | 2580             |
| 7590  | 01/04/2005  |                      | EXAMINER            |                  |
| MICHAEL A. RAHMAN<br>DORSEY & WHITNEY LLP<br>1420 FIFTH AVENUE, SUITE 3400<br>SEATTLE, WA 98101 |             |                      |                     | PHAN, TAM T      |
|   |             | ART UNIT             | PAPER NUMBER        | 2144             |

DATE MAILED: 01/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                        |                     |
|------------------------------|------------------------|---------------------|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |
|                              | 09/672,029             | RAMER ET AL.        |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |
|                              | Tam (Jenny) Phan       | 2144                |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 04 October 2004.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 35-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 35-38 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date. _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

1. Amendment received on 10/04/2004 has been entered. Claims 1-34 and 39-41 are canceled. Claims 35-36 and 38 are previously presented. Claim 37 is amended.
2. Claims 35-38 are presented for examination.

#### ***Priority***

3. This application claims benefit of the provisional application 60/156,956 (09/30/1999).
4. The effective filing date for the subject matter defined in the pending claims, which has support in provisional application 60/156,956 in this application, is 09/30/1999. Any new subject matter defined in the claims not previously disclosed in provisional application 60/156,956, is entitled to the effective filing date of 09/29/2000.

#### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 35-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over MacNaughton. (U.S. Patent Number 5,796,393), hereinafter referred to as MacNaughton, in view of Li et al. (U.S. Patent Number 6,631,496), hereinafter referred to as Li.

7. Regarding claim 35, MacNaughton disclosed a system for providing enhanced web-browsing comprising: a data double, comprising data that identifies a member

[membership context, membership data] (Abstract, Figure 5 sign 168, column 8 lines 24-42); service providers that provide service provider content including services and information; a personal site that the member uses to access the service provider content; an engine that processes the data double and the service provider content to provide content to the member through the personal site (Abstract, Figures 1-1B, 6, column 1 lines 19-34, column 3 lines 24-34, column 7 lines 15-33).

8. MacNaughton taught the invention substantially as claimed. However, MacNaughton did not expressly teach an engine that processes the service provider content to provide *relevant and meaningful* content to the member through the personal site.

9. MacNaughton suggested exploration of art and/or provided a reason to modify the system with the personalized feature (column 4 lines 24-32, column 7 lines 15-33, column 8 lines 9-23).

10. In an analogous art, Li disclosed an engine that processes the service provider content to provide relevant and meaningful content to the member through the personal site (Title, Abstract, Figures 1, 11, column 5 lines 19-33, column 6 lines 22-31).

11. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the system of MacNaughton with the teachings of Li to include the personalized feature in order to effectively retrieve content (Li, column 1 lines 32-41) since users would often encountered problems in finding information (Li, column 1 lines 32-41). In addition, personalized content could also provide subscription service, which retrieves user-specified interests (Li, Abstract) since this feature could be

used to display specific on-line content that the user has requested to receive (MacNaughton, column 7 lines 31-33).

12. Regarding claim 36, MacNaughton disclosed a system wherein the engine comprises identify management that manages the data double to establish a personal profile, member preferences, member permissions, and activity data for the member; and context management that organizes service provider content, coordinates browsing processes, and provides an adaptive framework (Figures 1B, 3, 5, column 4 lines 24-32, column 6 lines 25-37, column 7 lines 14-33, column 8 lines 9-23).

13. Regarding claim 37, MacNaughton disclosed a system wherein the personal site comprises: smart pages, comprising: a log in page; a home page; and inside pages; and an adaptive framework, comprising: selection navigators; and a toolbar (Figure 6, column 3 lines 24-34, lines 51-61, column 9 line 54-column 10 lines 11, column 12 lines 41-49).

14. Regarding claim 38, Li disclosed a system wherein the selection navigators provide direct page searching comprising: a fixed hierachal structure listing a web site's areas with sections and pages; an explicit SQL criteria search, whereby by the selection navigators gather and dynamically assemble web sites meeting the criteria; and a group SQL criteria, wherein the selection navigators store the criteria, gather and dynamically assemble web sites meeting the criteria and update the web sites when new content is found meeting the criteria (Figures 1-2, 5, 10-12A, 19, column 5 lines 19-33, column 7 lines 54-67, column 13 lines 35-56).

15. Since all the limitations of the claimed invention were disclosed by the combination of MacNaughton and Li, claims 35-38 are rejected.

### **Response to Arguments**

16. Applicant's arguments filed 10/04/2004 have been fully considered but they are not persuasive.

17. In response to applicant's argument relating to the Chakrabarti reference that the reference fails to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., search engine) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

18. However, in view of Applicant's arguments with respect to the data double being the subscriber's identity, the arguments have been fully considered and are persuasive. The rejection of claims 35-38 based on the Chakrabarti reference has been withdrawn.

19. In response to applicant's argument relating to the MacNaughton and Li references that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., search engine) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

20. For argument purposes, the Office would like to point out that Li taught the alleged search engine as presented in applicants' remark. Li disclosed "To enable

interactive search, a search engine usually provides a set of services for query of web information. Some of these services are offered only in certain search engines" (column 7 lines 55-58); "user-specific metadata records are maintained for the automated bookmarking services discussed in further below. Typically, associated with each user-specific metadata record is (a) the "user\_ID" field, specifying the identity of the user" (column 6 lines 22-31), and "Proxy server 122 collects a user's navigation and browsing history to allow PowerBookmarks to automatically adjust for different usage patterns, as well as to provide for an automated bookmarking service" (column 5 lines 28-31). It would be obvious then that Li disclosed a search engine that processes the user context information and the service provider content to personalize the member web site to provide relevant and meaningful content to the member.

21. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). As detailed in the above rejection, MacNaughton is relied upon to reject the a data double, comprising data that identifies a member and Li is relied upon to reject an engine that processes the service provider content to provide relevant and meaningful content to the member through the personal site.

22. MacNaughton disclosed "During the membership process, information about the user (e.g. preferences and profile data such as name, address, age, billing information, interests and hobbies, favorite Web sites, etc.) is collected and stored in the

Membership databases" (column 8 lines 29-33). According to applicants' remark, the data double is the same as the subscriber's identity, which identifies the subscriber and contains preference information about the subscriber. It is obvious then that the membership information and the user profile data disclosed in MacNaughton is the claimed data double comprising data that identifies a member. MacNaughton further disclosed, "Notifications are associated with communities and indicate or reference additional information or content (i.e., Community Content) as well as interaction options or methods that may be of interest to the user. As the user continues to browse or "surf" the Web, notifications may be send to the Community Client from the Community Server to let the user know what additional community capabilities or features are available for the current Web page or URL" (column 7 lines 16-24). Thus, MacNaughton obviously disclosed an engine that processes the data double and the service provider content to provide content to the member through the personal site

23. Furthermore, Li disclosed a system for personalizing web information to provide relevant and meaningful content to the member through the personal site. Refer to explanation in Paragraph 20.

24. As the rejection reads, Examiner asserts that the combination of these teachings render the claimed invention obvious.

### ***Conclusion***

25. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

26. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Refer to the enclosed PTO-892 for details.

27. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tam (Jenny) Phan whose telephone number is (703) 305-4665. The examiner can normally be reached on M-F 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Cuchlinski can be reached on 703-308-3873. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

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